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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/759,108	12/02/1996	JIAN QIN	12.975	6757
23556	7590	11/17/2004	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC. 401 NORTH LAKE STREET NEENAH, WI 54956			REDDICK, MARIE L	
			ART UNIT	PAPER NUMBER
			1713	

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

08/759,108

Applicant(s)

QIN ET AL.

Examiner

Judy M. Reddick

Art Unit

1713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/22/04;05/07/04;08/23/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-34 is/are pending in the application.
- 4a) Of the above claim(s) 17-32 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-16 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on 08/23/04 + the Terminal Disclaimer/Counsels Remarks filed on 03/22/04 are sufficient to overcome the Claim Rejections under 35 USC § 112, second paragraph & the Double Patenting rejection based on copending application 10/006,781 raised in the previous Office Action (11/20/03).

Election/Restrictions

2. Claims 17-32 & 34 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 2, 4-16 & 33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-32 of copending Application No. 10/627,061. Although the conflicting claims are not identical, they are not patentably distinct from each other because the absorbent structure comprising an upper surface and a lower surface(1-16) and disposable absorbent structure comprising a liquid-permeable topsheet, a backsheet attached to the topsheet, and an absorbent structure positioned between the topsheet and the back sheet (17-32) wherein the absorbent structure comprises a) a water-swellaable, water-insoluble polymer having acidic functional groups, wherein the water-swellaable, water-insoluble polymer has at least about 50 molar percent of the acidic functional groups in free acid form and wherein the water-swellaable, water-insoluble polymer is governed by a pKa of between about 0 to 12 and b) a basic material per the claims of U.S. copending application '061 overlaps in scope with the absorbent composition(1, 2 & 4-16) and disposable absorbent product comprising a liquid-permeable topsheet, a backsheet attached to the topsheet, and an absorbent structure positioned between the topsheet and the backsheet (33) wherein the absorbent composition and the absorbent structure comprise a mixture of a) an acidic water-swellaable, water-insoluble polymer having a pKa between about 2 and about 12 wherein the acidic water-swellaable, water-insoluble polymer comprises acidic functional groups and has at least about 50 molar percent of the acidic functional groups in free acid form and b) a basic material per the instantly claimed invention.

As to the property limitations per the instant claims, it would be expected that the limitations would be inherent in the absorbent composition recited in the claims of U.S. copending'061.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claims 1, 2, 4-16 & 33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of U.S. Patent No. 6,639,120 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the absorbent structure (1-15) and disposable absorbent product (16-30) comprising a) a water-swellaable, water-insoluble polymer having acidic functional groups, wherein the water-swellaable, water-insoluble polymer has at least about 50 molar percent of the acidic functional groups in free acid form, b) a basic material and c) a buffering agent overlaps in scope with the absorbent composition(1, 2 & 4-16) and disposable absorbent product comprising a liquid-permeable topsheet, a backsheet attached to the topsheet, and an absorbent structure positioned between the topsheet and the backsheet (33) wherein the absorbent composition and the absorbent structure comprise a mixture of a) an acidic water-swellaable, water-insoluble polymer having a pKa between about 2 and about 12 wherein the acidic water-swellaable, water-insoluble polymer comprises acidic functional groups and has at least about 50 molar percent of the acidic functional groups in free acid form and b) a basic material per the instantly claimed invention.

As to the property limitations per the instant claims, it would be expected that the limitations would be inherent in the absorbent composition recited in the claims of U.S. Patent '120.

Evidence of Common Ownership

6. Claims 1, 2, 4-16 & 33 are directed to an invention not patentably distinct from claims 1-32 & claims 1-30 of commonly assigned U.S. Copending application 10/627,061 & U.S. Patent 6,639,120 B1, respectively, as per reasons already stated in paragraph nos. 3 & 4.

7. The U.S. Patent and Trademark Office normally will not institute interference between applications or a patent and an application of common ownership (see MPEP 2302). Commonly assigned Application No. 10/627,061 and U.S. Patent 6,639,120 B1, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the

examiner to resolve this issue, the assignee is required under 37 CFR 1.78(c) and 35 U.S.C. 132 to either show that the conflicting inventions were commonly owned at the time the invention in this application was made or to name the prior inventor of the conflicting subject matter. Failure to comply with this requirement will result in a holding of abandonment of the application. A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications filed on or after November 29, 1999.

Applicant is reminded of the new rules for evidence of Common ownership set forth in the OG Notice of 12/26/01 "Guidelines Setting Forth a Modified Policy the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c) which states: Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicants or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

Response to Arguments

8. Applicant's arguments, see the paper filed 03/22/04, with respect to the rejection(s) of claim(s) 1, 2, 4-16 & 33 under the judicially created doctrine of obviousness-type double patenting over the claims of copending application 10/006,781 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made based on the claims (1-32) of copending application 10/627,061 and the claims (1-30) of U.S. Patent 6,639,120, as set forth supra.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Judy M. Reddick
Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR *JMR*
11/09/04